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EXAMINER	
VETTER, DANIEL	
ART UNIT	PAPER NUMBER
3628	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/677,829	OGG, CRAIG	
	Examiner	Art Unit	
	DANIEL P. VETTER	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 December 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-27 and 39-52* is/are pending in the application.

4a) Of the above claim(s) *39-52* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

1. Claims 14-27 and 39-52 are currently pending in this application, of which 39-52 are withdrawn from consideration.

Election/Restrictions

2. Applicant's attempted traversal of the restriction in the reply filed on December 16, 2008 is acknowledged. The traversal is on the ground(s) "that the only reasons for a serious burden being present that appears to apply is due to the fact that the claim groups are in the same class, but fall into different subclasses of search." Remarks, 6. Applicant also notes that the different inventions share certain features. While examiner acknowledges that certain issues may be shared by both inventions, others are not. For example, the different inventions would require different search strategies beyond subclasses (including different terms and/or databases), and different art would likely be cited. Moreover, the claims present different issues under §§ 101 and 112. Accordingly, a serious burden exists for these inventions to be examined together. The requirement is still deemed proper and is therefore made FINAL.

Response to Arguments

3. Applicant's arguments filed December 16, 2008 with respect to the rejections made under § 103(a) have been fully considered but they are not persuasive. Applicant argues that the systems of Pierce and Willoughby are not combinable. Examiner respectfully disagrees and maintains that the combined teachings render the claimed invention unpatentable under § 103(a). In the supplied remarks, applicant makes a series of factual statements unsupported by the record, and does not supply any additional evidence to support the assertions. Regarding the cited references, applicant states that "it is clear that they cannot be readily combined by one with skill in the art. Remarks, page 8. Similarly, "one with skill in the art could not readily integrate these systems." Remarks, page 9. Arguments of counsel cannot take the place of factually

supported objective evidence. *In re Huang*, 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984).

Nothing in Pierce's disclosure would make it impossible or even unworkable to add remote vendors. Indeed, remote vendors would be highly desirable if the meters in the event that the local meters all run out of funds. Examiner acknowledges that the systems disclosed by Pierce and Willoughby would have redundant and potentially interfering elements if the entire system of Willoughby was crudely attached to the networked meters in Pierce. Applicant presupposes that the shipping system API of Willoughby must be included in the combination, and bases a number of arguments off of this contention that the systems would interfere with each other. No evidence has been submitted and no citations to the record are provided to support this factual assertion. Arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Applicant cites to some passages of the cited art in the subsequent arguments, but none of the cited passages provide evidence sufficiently germane or supportive of applicant's assertions of incompatibility. The level of skill in the art is such that Pierce's system could be configured to support the multiple remote vendors described by Willoughby without difficulty. Accordingly, the rejections are maintained.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 14-18, 20-21, and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce, et al., U.S. Pat. No. 6,151,591 (Reference A of the PTO-892

part of paper no. 20071012) in view of Willoughby, et al., Intl. Pat. Pub. No. WO 02/093498 (Reference N of the PTO-892 part of paper no. 20080910).

6. As per claim 14, Pierce teaches a method of accessing a remote postage account from a local postage evidencing device, comprising: connecting to a remote postage evidencing system via a local postage evidencing device (col. 5, lines 40-42), said local postage evidencing device having a local postage account (col. 5, lines 40-41); identifying a remote postage account on the remote postage evidencing system that is to be used to print postage on the local postage evidencing device (col. 5, lines 62-63); selecting a desired postage amount to be printed on the local postage evidencing device (col. 7, line 48); reducing a balance on the remote postage account (col. 5, lines 66-67) without transferring the value of the postage amount to the local account, thereby maintaining a same local postage account balance (col. 3, lines 45-50); and printing the desired postage amount on the local postage evidencing device (col. 8, lines 2-4). Although Pierce teaches providing access to a plurality of remote postage accounts (e.g., in Fig. 7), Pierce does not explicitly teach configuring the local postage evidencing device to communicate with a plurality of vendors providing access to a plurality of remote postage accounts, and that the identified account is administered by a selected vendor of said plurality of vendors; which is taught by Willoughby (¶ 0018). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Willoughby so that a user can select another vendor if a particular remote postage provider suffers downtime or exits the industry (as taught by Willoughby; ¶ 0012). Moreover, this is merely a combination of old elements in which each would serve the same function as it did separately, and the addition of this feature to the method disclosed by Pierce could be implemented through routine engineering producing predictable results.

7. As per claim 15, Pierce in view of Willoughby teaches the method of claim 14 as described above. Pierce further teaches printing the desired postage amount on the local postage evidencing device without reducing a balance on the local postage account (col. 6, lines 4-6).

8. As per claim 16, Pierce in view of Willoughby teaches the method of claim 14 as described above. Pierce further teaches authenticating a user with the remote postage evidencing system (col. 8, line 50).

9. As per claim 18, Pierce in view of Willoughby teaches the method of claim 14 as described above. Pierce further teaches connecting to the remote postage evidencing system using a wireline connection (col. 7, line 14).

10. As per claim 17, Pierce in view of Willoughby teaches the method of claim 14 as described above. Willoughby further teaches connecting to the remote postage evidencing system using a wireless connection (¶ 0027). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Willoughby because wireless networks are known alternatives to other communications networks (as taught by Willoughby; ¶ 0027). Moreover, this is merely the simple substitution of a wireless network for the wired network used for the same purpose as disclosed in Pierce, and could be implemented through routine engineering producing predictable results.

11. As per claim 20, Pierce in view of Willoughby teaches the method of claim 14 as described above. Pierce further teaches the local postage evidencing device is a postage meter (col. 11, line 65).

12. As per claim 21, Pierce in view of Willoughby teaches the method of claim 20 as described above. Pierce further teaches the local postage account is a register that reflects the amount of postage that is currently authorized on the device (col. 10, lines 60-62).

13. As per claim 24, Pierce in view of Willoughby teaches the method of claim 14 as described above. Pierce further teaches the local postage evidencing device is a personal computer coupled to a printer (col. 5, lines 24-25).

14. As per claim 25, Pierce in view of Willoughby teaches the method of claim 24 as described above. Pierce further teaches the local postage account is a stored value of postage that has been downloaded from an Internet-based postage service (col. 2, lines 47-49).

15. As per claim 26, Pierce in view of Willoughby teaches the method of claim 14 as described above. Pierce further teaches the remote postage account is an Internet-based postage service (col. 3, lines 51-55). Willoughby further teaches that the account is associated with a vendor (¶ 0018), which would have been obvious to incorporate for the same reasons stated above with respect to claim 14.

16. As per claim 27, Pierce in view of Willoughby teaches the method of claim 14 as described above. Willoughby further teaches the remote postage evidencing account comprises a postage account established by the United States Postal Service (¶ 0007). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Willoughby because the USPS is the entity responsible for authorizing postage vendors that supply postage to be used in the USPS mail stream (as taught by Willoughby; ¶¶ 0003, 07).

17. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce, et al. in view of in view of Willoughby, et al. as applied to claim 14 above, further in view of Lee, et al., U.S. Pat. No. 5,742,683 (Reference C of the PTO-892 part of paper no. 20071012).

18. As per claim 19, Pierce in view of Willoughby teaches the method of claim 14 as described above. Pierce in view of Willoughby does not teach identifying a user to the local postage evidencing device using a biometric input; which is taught by Lee (col. 8, line 22). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Lee because biometric data is a known manner of securely authenticating users, similar to a password (as taught by Lee; col. 8, lines 17-22). Moreover, this is merely a combination of old elements in which each would serve the same function as it did separately, and the addition of this feature to the method disclosed by Pierce could be implemented through routine engineering producing predictable results.

19. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce, et al. in view of Willoughby, et al. as applied to claim 14 above, further in

view of Eddy, et al., U.S. Pat. No. 5,812,400 (Reference D of the PTO-892 part of paper no. 20071012).

20. As per claim 22, Pierce in view of Willoughby teaches the method of claim 14 as described above. Pierce in view of Willoughby does not teach the local postage evidencing device is a postage dispensing kiosk; which is taught by Eddy (col. 3, line 57). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Eddy in order to provide the increased functionality and utility to kiosk meter users (as taught by Eddy; col. 3, lines 57-59). Moreover, this is merely the simple substitution of a kiosk for the terminal device used for the same purpose as disclosed in Pierce, and could be implemented through routine engineering producing predictable results.

21. As per claim 23, Pierce in view of Willoughby and Eddy teaches the method of claim 22 as described above. Pierce further teaches the local postage account is an amount of postage purchased by a user at the device (col. 5, line 41). Eddy further teaches the device is a kiosk which would be obvious for the same reasons as in claim 22 above.

Conclusion

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL P. VETTER whose telephone number is

(571)270-1366. The examiner can normally be reached on Monday through Thursday from 8am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W Hayes/
Supervisory Patent Examiner, Art Unit 3628